

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

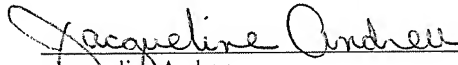
In re Application of: Eric Bornstein  
Serial No: 10/821,442  
Filing Date: 09 April 2004  
Title: INSTRUMENT FOR DELIVERY OF OPTICAL ENERGY TO THE  
DENTAL ROOT CANAL SYSTEM FOR HIDDEN BACTERIAL AND  
LIVE BIOFILM THERMOLYSIS  
Art Unit: 3732  
Examiner: Lewis, Ralph A.  
Confirmation No. 1341  
Docket No: 72287-015

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date: 28 November 2007

  
Jacqueline Andreu

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Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
UNDER 37 CFR §1.181**

Dear Sir:

Applicant respectfully petitions for the United States Patent and Trademark Office to withdraw the holding of abandonment based on failure to pay the required Issue and Publication fees in connection with the above-referenced application. As explained in the following statements, the Applicant's attorneys have not as of this date received a Notice of Allowance and Fee(s) Due (PTOL-85) for the above-referenced application.

A Final rejection was issued for the subject application on 27 September 2006. In response, Applicant filed a Request for Continued Examination ("RCE") with claim amendments and remarks on 29 January 2007, as reflected in Office's PAIR database.

On 13 April 2007, Applicant's attorney held a phone discussion with Examiner Lewis regarding a potential After Final amendment for the subject application, and was advised to file the amendment under 37 CFR § 1.312 because he was going to allow the application. Subsequently, on 13 April 2007, an After Final amendment was prepared and submitted on behalf of the Applicant.

On 19 July 2007, Applicant's attorney spoke with Examiner Lewis and informed the examiner that no Notice of Allowance and Fees Due (PTOL-85) forms had been received by MWE personnel. During the phone call, Examiner Lewis indicated that everything looked in order for the subject application and that he would be sending out a Notice of Allowance that day or the next.

Examiner Lewis subsequently initialed the After-Final amendment submitted on 13 April 2007, as indicated by the entry in PAIR on 10 August 2007. PAIR also indicates that Notices of Allowance and Fees Due (PTOL-85) are indicated as having been mailed on the following dates:

(a) 19 April 2007 (two instances) - although examination of the image file wrapper in PAIR shows that one of the PTOL-85 entries for 19 April 2007 was actually a Notice of Allowability;

(b) 29 May 2007 - examination of the image file wrapper in PAIR shows that this PTOL-85 entry was actually an Examiner's amendment;

(c) 10 August 2007 - examination of the image file wrapper in PAIR shows that this PTOL-85 entry was actually a Supplemental Notice of Allowability; and

(d) 28 September 2007 - examination of the image file wrapper in PAIR shows that this PTOL-85 entry was actually a Second Supplemental Notice of Allowability.

All of these notices are shown to have been mailed to the Miami office of MWE, despite the filing of a notice of change of correspondence address filed on 24 July 2006 requesting all future

correspondence be forwarded to the Boston office of MWE.

None of the referenced documents in (a) and (b), *supra*, have been received by the Miami and Boston offices of MWE. The Miami office of MWE did receive the Supplemental and Second Supplemental Notices of Allowability referenced in (c) and (d), *supra*. These documents were subsequently forwarded to the Boston office of MWE.

On 12 October 2007, Applicant's attorney called Examiner Lewis, after examining PAIR and noticing that a Notice of Allowance and Fees due (PTOL-85) was indicated as being mailed on 28 September 2007, to inform the Examiner that in fact no Notice of Allowance and Fees due (PTOL-85) had been received for the subject application and to inquire about its status since he was confused by the numerous entries of notices of allowance that were indicated as having been mailed, and yet none had been received. Examiner Lewis indicated during the telephone call that he would send an email to his docketing clerk to inquire as to the status of the case.

Subsequent to that telephone call, a Notice of Abandonment was mailed on 22 October 2007 for the subject application. The Notice of Abandonment was received by the MWE Miami office personnel and forwarded to the IP Department of the Boston office of MWE.

In a subsequent telephone conference with Examiner Lewis on 07 November 2007, Examiner Lewis acknowledged that he was aware that the Notice of Allowance was never received by MWE. His supervisor, Chris Rodriguez, indicated during a call on 16 November 2007 that she was alarmed at the record, i.e., that five Notices of Allowance were indicated on PAIR as having been entered but that she had no authority to review the holding of abandonment and that this petition was necessary to withdraw the abandonment holding.

The Notice of Abandonment stated that the subject application became abandoned for failure to pay the Issue Fee and Publication Fees within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85). The actual due date that the issue and publication fees were due is not indicated in the Notice of Abandonment. As explained herein, Applicant and Applicant's attorneys have never received any Notice of Allowance (PTOL-85) for the

Serial No. 10/821,442  
Petition to Withdraw Holding of Abandonment Under 37 CFR § 1.181  
Reply to Notice of Abandonment  
Date: 28 November 2007

subject application.

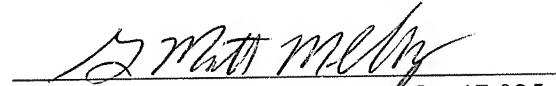
Further, Applicant's attorney has made a search of his files and has reviewed the docket records kept by Applicant's attorney which indicate that the Notice of Allowance was never received in connection with the above-identified application. A copy of the docket record where the non-received Office communications would have been entered had it been received and docketed is attached as Exhibit A.

For the foregoing reasons, Applicant respectfully petitions for the Office to withdraw the holding of abandonment for the subject application.

The Commissioner is hereby authorized to charge any fees that are required for the subject application, including any fees required for the submission of this Petition, or credit any overpayment, to Deposit Account No. 50-1133.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



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Boston, Massachusetts 02109

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Date: 28 November 2007

## **Exhibit A**

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**Country Application****Matter:** 072287-0015**/ednesday, November 28, 2007****Page: 1**

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**Family Number:** 072287-0029**SubCase:** 2**Country:** US      United States of America**Client:** Nomir Medical Technologies**Family Name:** NOMS-15**Sub Matter:** NOMS-0015**Group Art No.:** 3732**Client Reference #:****Responsible Atty.:** THK      **Assigned Atty.:** GMM      **Paralegal:**      **Other MWE Office Contact:****Case Type:** ORD**Application Status:** Published**Earliest Priority Date:** 08-May-2003**Filing Date:** 09-Apr-2004**Application Number:** 10/821,442**Publication Number:** 04-0224288**Publication Date:****Patent Number:****Issue Date:****Parent/PCT Number:** 60/468,944**Parent/PCT Date :** 08-May-2003**Parent Issue Number:****Parent Issue Date :****Tax Schedule:** LE**Expiration Date:****Confirmation #:** 1341**Patent Term Adjustment:** 0**Owner:****Owner Reference #:****Agent:** MWEBO**Agent Reference #:**

McDermott Will &amp; Emery - Boston

**App.Title:** INSTRUMENT FOR DELIVERY OF OPTICAL ENERGY TO THE DENTAL  
ROOT CANAL SYSTEM FOR HIDDEN AND LIVE BIOFILM THERMOLYSIS**Family Reference:**

**List Of Actions**

Action(s) Due	Due Date		Action Taken
File Assignment	09-May-2005	Due Date	01-Jan-1930
Information Disclosure Stmt	09-May-2005	Due Date	01-Jan-1930
RESPONSE DUE 1 MONTH	03-Jul-2005	Reminder	01-Jan-1930
RESPONSE DUE	03-Aug-2005	Due Date	01-Jan-1930
RESPONSE DUE 1 EXT	03-Sep-2005	Due Date	01-Jan-1930
RESPONSE DUE 2 EXT	03-Oct-2005	Due Date	01-Jan-1930
NON-EXTBL. RESPONSE 2 WKS	17-Oct-2005	Reminder	01-Jan-1930
NON-EXTBL. RESPONSE DUE	03-Nov-2005	Final	02-Nov-2005
2MON REM-3 MON FINAL OA DUE	25-Feb-2006	Reminder	01-Jan-1930
1MON REM-3 MON FINAL OA DUE	25-Mar-2006	Reminder	01-Jan-1930
OA RESPONSE-2 MONTH DUE DATE	25-Mar-2006	Due Date	01-Jan-1930
2WK REM-3 MON FINAL OA DUE	11-Apr-2006	Reminder	01-Jan-1930
1WK REM-3 MON FINAL OA DUE	18-Apr-2006	Reminder	01-Jan-1930
RESP 3MONTH FINAL OA DUE TOD	25-Apr-2006	Due Date	01-Jan-1930
RESP 3 MON FINAL OA W/1MON EO	25-May-2006	Due Date	01-Jan-1930
RESP 3 MON FINAL OA W/2MON EO	25-Jun-2006	Due Date	24-Jul-2006
L/D RESP TO 3 MON FINAL OA	25-Jul-2006	Final	24-Jul-2006
L/D TO FILE NOTICE OF APPEAL	25-Jul-2006	Final	24-Jul-2006
L/D TO FILE RCE	25-Jul-2006	Final	24-Jul-2006
RCE Filed - Check Status	24-Oct-2006	Due Date	27-Sep-2006
File IDS	25-Oct-2006	Due Date	25-Aug-2006
Response Due - 1 Month	27-Nov-2006	Reminder	29-Jan-2007
Response Due	27-Dec-2006	Reminder	29-Jan-2007
Response Due / 1st Extension	27-Jan-2007	Reminder	29-Jan-2007
Response Due / 2nd Extension	27-Feb-2007	Due Date	29-Jan-2007
File IDS	14-Mar-2007	Due Date	14-Mar-2007
Response Due - 2 weeks	14-Mar-2007	Due Date	29-Jan-2007
Response FINAL/Not. of Appeal	27-Mar-2007	Final	29-Jan-2007
RCE Filed - Check Status	29-Apr-2007	Due Date	19-Apr-2007
Interview Summary	19-May-2007	Final	03-May-2007
Search Results [3EP] - 1 Mth	24-Sep-2007	Reminder	25-Oct-2007
FINAL - Search Results [3EP]	24-Oct-2007	Final	25-Oct-2007
File Assignment	31-Jan-2008	Due Date	